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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,879

08/18/2003

David Morrow

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

03/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/642,879	Applicant(s) MORROW ET AL.	
	Examiner MIKE CHAMBERS	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41,42,44-47,50-52 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41,42,44-47,50-52 and 54-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim language discloses "a first range extends around 120 degrees". This information is not disclosed in the specification and cannot be determined by the original drawings; therefore it is considered "new matter".

Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim language discloses "a third range extends between about 9 degrees to about 17 degrees". This information is not disclosed in the specification and cannot be determined by the original drawings; therefore it is considered "new matter".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-42, 48, 50-52, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow et al (5568925) in view of Merola (3697069) and HauteStick. Morrow discloses a hollow shaft (fig 1, 3:46-49). HauteStick discloses it is old to desire to strengthen a portion of the shaft to increase its strength for checking the user's opponent (page 4). Merola discloses an eccentric shaft to strengthen the (fig 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the eccentric cross sectional shape of Merola with Morrow in order to increase the strength of the shaft for checking during play.

As to claim 42: Merola discloses a substantially constant wall thickness with a first range of at least 180 degrees (fig 5). Note: The specification provides no unexpected or surprising results in using limitation; therefore it is considered a design choice. It would have been obvious to one of ordinary skill in the art to have selected any one of several first ranges based on the design criteria of the machines making the extruded shafts.

As to claim 44: The specification provides no unexpected or surprising results in using the limitation; therefore it is considered a design choice. An eccentric shaft having a hexagonal cross sectional shape would naturally have multiple ranges of thicknesses.

As to claim 45: Merola discloses a substantially constant wall thickness around a first and second range (fig 5).

As to claims 46-47: The specification provides no unexpected or surprising results in using these limitations; therefore they are considered design choices. The amount of eccentricity to a shaft and this wall thickness depends on the limitations of the equipment and the desires of the person designing the shaft.

As to claim 50: The specification provides no unexpected or surprising results in using limitation; therefore it is considered a design choice. An eccentric shaft having a polygonal cross sectional shape would naturally have over half the sides thicker since walls adjacent the thicker wall would have thin and thick wall segments. And thus could be counted with either the thick or thin wall segments.

As to claim 51: Morrow discloses a polygonal cross-sectional tube with adjacent sides (3:46-49). The eccentric shaft of Merola would naturally have this limitation in an octagonal shaped shaft.

As to claim 52: The eccentric shaft of Merola using the octagonal shaped shaft of Morrow would naturally have this limitation depending on where the axis was drawn. The specification provides no unexpected or surprising results in using these limitations; therefore they are considered design choices.

As to claim 54: See claim 41 rejection.

As to claim 55: See claim 50 rejection.

As to claim 56: Morrow discloses a rounded corner (fig 7).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41 and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 7,404,775. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are simply broader than the patent claims and clearly "read" on the claims in the patent.

Response to Arguments

Applicant's arguments filed 12/8/08 have been fully considered but they are not persuasive. As noted by HauteStick it is desirable to strengthen the shaft due to the checking of players during game play. One of ordinary skill in the art would not only

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choose the means shown by HauteStick to strengthen the stick but would also look to other ways to strengthen the shaft. These are merely obvious variations.

It should be noted that the 10/27/08 interview was of a general nature and no agreement was reached that the inclusion of claim 43 into claim 41 would make claim 41 allowable. Since the examiner does not have a formally submitted set of modified claims to review prior to an interview, it is this examiner's standard policy never to agree that claims are allowable in an interview. Therefore, the examiner apologizes if the examiner left the applicant's representative with the impression the claims were allowable after the interview.

Also, no terminal disclaimer was found in the response, therefore the double patenting rejection remains.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers
Examiner
Art Unit 3711

March 11, 2009

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711